

REMARKS

Claims 1-6, as amended, and new claims 7-11 appear in this application for the Examiner's review and consideration. Claims 1-6 have been amended to more particularly point out the claimed subject matter and to correct inadvertent minor spelling and editorial errors, but no new matter has been added. Claim 1 has been amended to recite "with respect to the weight of the gabapentin; more than 20 ppm of an anion of a mineral acid with respect to the weight of the gabapentin." The amendment to claim 1 is supported in the specification at p. 5, ll. 17-20. New claims 7 and 8 are supported in the specification at p. 6, ll. 1-12. New claim 9 is supported by claim 1 and in the specification by Example 5, in particular at p. 12, ll. 14-16. New claims 10 and 11 are supported in the specification at p. 8, ll. 27-29 and Examples 2-9 and 15.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as rendered obvious over WO 00/58268 to Tenconi *et al.* in view of WO 00/07568 to Bruna *et al.* for the reasons set forth on pages 2-4 of the Office Action. Applicants respectfully traverse.

The cited WO 00/58268 publication to Tenconi *et al.* and WO 00/07568 publication to Bruna *et al.* are unavailable as a reference for the § 103 rejection. The requirements to determine whether an international reference is available as prior art under § 102(e) are summarized in the MPEP 706.02. See MPEP 706.02(f)(1) (Revised May 2004). Briefly, if the potential reference resulted from an international application then the international application must meet the following criteria (1) **have an international filing date on or after November 29, 2000**; (2) designate the United States; and (3) **published under PCT article 21(2) in English**. (Emphasis added). For U.S. application publications which claim the benefit of an internal application filed prior to November 29, 2000, apply the reference under 35 U.S.C. § 102(e) as of the actual filing date of the later-filed US application.

The '268 publication published in English on October 5, 2000 from international application No. PCT/EP00/02345, filed on March 16, 2000. The present application's earliest effective priority date is June 16, 2000, *i.e.*, the filing date of U.S. provisional application No. 60/211,966. Because the earliest priority date of the application is prior to the publication date of the '268 publication, the '268 publication is not available as a § 102(b) reference. The '268 publication is not available as a § 102(e) and thus potentially a § 103 reference, because the '268 publication was filed before November 29, 2000. The § 371 (c)(1) date of the corresponding U.S. patent No. 6,576,790 is February 25, 2002, which is more than one after the application's earliest priority date. Consequently, the '268 publication is unavailable as a reference.

The '568 publication published in French on February 17, 2000. The present application's earliest effective priority date is June 16, 2000, the filing date of U.S. provisional application No. 60/211,966. Thus, because the earliest priority date of the application is less than one year after the publication date of the '568 publication, the '568 publication is not available as a § 102(b) reference. The '568 publication is not available as a § 102(e) and thus potentially a § 103 reference, because two of the necessary requirements are not met. The '568 publication was filed on July 23, 1999, before the required date of November 29, 2000, and was published in French, not English. The actual filing date of the corresponding U.S. patent No. 6,488,964 is February 5, 2001, which is after the earliest priority date of the application. Consequently, the '568 publication is unavailable as a reference.

Because neither reference is available to establish a rejection under 35 U.S.C. § 103, we do not address in detail the merits of the argument. Alternatively, applicants contend that neither reference meets the consistent criterion for determination of obviousness, because neither reference would have suggested to one of ordinary skill in the art that claimed subject matter should be carried out and would have a reasonable likelihood of success. See, *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).


Accordingly, because neither reference cited is available to establish a rejection of claims 1-6 under 35 U.S.C. § 103(a), the rejection cannot stand and should be withdrawn.

Accordingly, it is believed that claims 1-6 are now in condition for allowance, early notice of which would be appreciated.

If any outstanding issues remain, the examiner is invited to telephone the undersigned at the telephone number indicated below to discuss the same. No fee is believed to be due for the submission of this response. Should any fees be required, please charge such fees to Kenyon & Kenyon, LLP Deposit Account No. 11-0600.

Respectfully submitted,

Dated: 2/24/05

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